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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET NO.	CONFIRMATION NO.
09/602,892	06/23/2000	Oz Gabai	6727/1E304-US1	1911

7590  
Darby & Darby PC  
805 Third Avenue  
New York, NY 10022

12/23/2003

EXAMINER
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CHENG, JOE H

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/602,892

Applicant(s)

GABAI ET AL.

Examiner

Joe H. Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 58-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant is informed that the Preliminary Amendment of August 14, 2000 is filed before the Office action (Paper No. 5) mailed May 8, 2001. Hence, the Office action (Paper No. 5) is hereby withdrawn, and the supplemental Office action as set forth below. Moreover, in response to the Preliminary Amendment filed on August 14, 2000, claims 1-57 have been cancelled, and the newly added claims 58-64 are pending. Further, it appears that the instant application, based on the newly added claims, is a continuation of the application Serial No. 09/081,255 and is not a divisional application of the application Serial No. 09/081,255. Correction is required.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

The term "This is a division, of application Serial No. 09/081,255, filed May 19, 1998. Each of these prior applications is hereby incorporated herein by reference, in its entirety." On Pg. 1, line 1, should be recited as --This is a continuation of application Serial No. 09/081,255, filed May 19, 1998, now U.S. Patent No. 6,160,986, which is hereby incorporated herein by reference in its entirety.--, so as to clarify the status. Further, the term "Fig. 24 is a drawing showing a creature equipped with a build-in video camera and video display;" on Pg. 18, line 25, should be recited as --Fig. 24C is a drawing showing a creature equipped with a build-in video camera and video display;--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 58-64 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claims 58, 60, 63 and 64, the references for the “script information storage unit” (as per claims 58 and 63) and the “content controller operative to log information, received from the user input receivers, characterizing past interactions between each user and toy, and to utilize the information relating to past interactions, to subsequently control at least one of the toys” (as per claims 60 and 64) are unclear.

Claims 59, 61 and 62 are rejected for incorporating the above errors from their respective parent claims by dependency.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 58, 59 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Tong (U.S. Pat. No. 5,636,994). Figs. 1-6 of Tong broadly discloses the method and interactive toy apparatus for comprising the toy (23, 43) having a fanciful physical appearance, the speaker (31),

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the user input receiver (13, 14, 42, 63), the script information storage unit (19, 21 or download through the modem) for storing information to at least one script, and the content controller (12) operative in response to current user input received via the user input receiver and to information stored in the storage unit for providing audio content to user via speaker, and to perform interactive branching which employs at least one branching point to provide audio content (see column 2, line 59 to column 3, line 16).

***Claim Rejections - 35 USC § 103***

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 60-62 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tong (U.S. Pat. No. 5,636,994) in view of Sato (U.S. Pat. No. 4,858,930). It is noted that the teaching of Tong does not specifically disclose the log information (as per claims 60 and 64) as required. However, the teaching of Sato broadly discloses that such feature of logging information of the past interactions between the user and the toy and utilizing the information relating to past interactions to subsequently control at least one of the toys (see Fig. 9 and from column 4, line 5 to column 14, line 21) is old and well known. Hence, it would have been obvious to one of ordinary skill in the art to modify the method and system of Tong with the feature of the logging information as taught by Sato as both Tong and Sato et al are directed to system and method for operating interactive toys, so as to provide the past interactions of the user and the toy and resuming the control relating to the past interactions.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Endo (U.S. Pat. No. 4,752,068) - note Figs. 1 and 2;

Best (U.S. Pat. No. 5,358,259) - note Figs. 1-9;

Gabai et al (U.S. Pat. No. 6,206,754 B1) - note Figs. 1-62;

Brown et al (U.S. Pub. No. 2001/0032278 A1) - note Figs. 1-17;

Ho (U.S. Pat. No. 6,439,956 B1) - note Figs. 1-7.

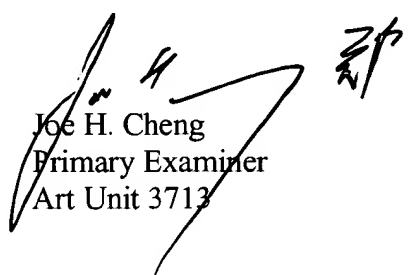
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue. - Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703)308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Joe H. Cheng  
December 15, 2003



Joe H. Cheng  
Primary Examiner  
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